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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,157	12/20/2001	Richard E. Fulton	ARTM 1000-6US	1695
34263	7590	02/02/2004		
O'MELVENY & MEYERS 114 PACIFICA, SUITE 100 IRVINE, CA 92618			EXAMINER SZMAL, BRIAN SCOTT	
			ART UNIT	PAPER NUMBER
			3736	
DATE MAILED: 02/02/2004				

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,157

Applicant(s)

FULTON ET AL.

Examiner

Brian Szmaj

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-17, 37-45 and 55-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-17 and 37-45 is/are allowed.
- 6) ☒ Claim(s) 55-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 55-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Corbitt, Jr. et al.

Corbitt, Jr. et al disclose a bioabsorbable breast implant and further disclose an elongate tubular member having a proximal end a distal end and a lumen therebetween; a bioresorbable body contained within the elongate tubular member, the bioresorbable body comprising polylactic acid and polyglycolic acid; a radiopaque marker carried by the bioabsorbable body; the bioresorbable body is remotely visualizable; the radiopaque marker is contained within the bioresorbable body; the bioabsorbable body comprises at least one bioresorbable body; the bioresorbable body swells upon contact with body fluid; and the bioresorbable body swells to substantially fill the biopsy site. See Column 2, lines 41-48 and 66-67; Column 3, lines 1-9, 15-21 and 40-53; and Column 4, lines 5-16 and 31-41.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 61-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foerster et al ('055) in view of Corbitt, Jr. et al.

Foerster et al disclose a device and method for marking biopsy sites and further disclose providing a bioresorbable body having a radiopaque marker carried by the bioresorbable body; removing a biopsy specimen; inserting the bioresorbable body at the biopsy site to mark the location of the site; testing the biopsy specimen; relocating the biopsy site by detecting the radiopaque marker; the bioresorbable body comprises at least one bioresorbable body; the marker is contained within the bioresorbable body; and the radiopaque marker is detected by mammography or ultrasound. See Abstract; Column 7, lines 66-67; Column 8, lines 1-49 and 65-67; Column 9, lines 1-4; Column 12, lines 50-57; and Column 13, lines 30-36.

Foerster et al however fails to explicitly disclose the use of polylactic acid or polyglycolic acid as the bioresorbable materials; the bioresorbable body swells in contact with body fluids; and the bioresorbable body swells to substantially fill the biopsy site.

Corbitt, Jr. et al, as discussed above, disclose a bioresorbable implant placed at a biopsy site and further disclose the use of polylactic acid or polyglycolic acid as the bioresorbable materials; the bioresorbable body swells in contact with body fluids; and

Art Unit: 3736

the bioresorbable body swells to substantially fill the biopsy site. See Column 2, lines 41-48 and 66-67; Column 3, lines 1-9, 15-21 and 40-53; and Column 4, lines 5-16 and 31-41.

Since both Foerster et al and Corbitt, Jr. et al disclose means for marking biopsy sites using a bioresorbable radiopaque body, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the particulars of Corbitt, Jr. et al, in particular a swellable bioresorbable body, since it would provide a means of hemostasis as well as a means for marking the biopsy site for future reference while allowing the device to eventually degrade if further procedures are not necessary.

Allowable Subject Matter

5. The following is a statement of reasons for the indication of allowable subject matter: Claims 4-17 and 37-45 remain allowable per the reasons set forth in Paper No. 7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmaj who's telephone number is (703) 308-3737. The examiner can normally be reached on Monday-Friday, with second Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-2701. The fax phone

Application/Control Number: 10/027,157

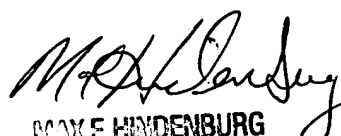
Page 5

Art Unit: 3736

number for the organization where this application or proceeding is assigned is (703)

872-9306.

BS



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SUPERVISOR/PATENT EXAMINER
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